

**REMARKS**

In the present Amendment, independent claim 6 has been amended to incorporate the recitations of claims 8 and 20, and claims 8 and 20 have been canceled, accordingly. Further, consistent with the amendment to claim 6, claim 9 has been canceled.

Upon entry of the Amendment, which is respectfully requested, claims 6 and 7 will be pending. No new matter has been added and entry of the Amendment is respectfully requested.

In Paragraph No. 2 of the Action, claims 6-9 and 20 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Nozaki et al. (US 6,013,416).

The Examiner states that the claimed invention is drawn to a positive photoresist composition comprising a resin which has an ester group represented by the general formula (I-2) in the molecule and is decomposed by the action of an acid to increase solubility of the resin in an alkali solution, and a compound generating an acid by irradiation with an active light or radiation, wherein in formula (I-2), R21 to R24, which may be the same or different, each represents a hydrogen atom or an alkyl group, and m represents 1 or 2.

The Examiner states that Nozaki et al. anticipates the invention at Example 66 wherein a copolymer made from 2-methyl-2-adamantyl methacrylate and alpha-acrylic acid-(R)-(+)-beta, beta-gamma-butyrolactone is exemplified. Per the Examiner, this copolymer in the photoresist anticipates the invention of present claims 6-9 and 20.

Applicants submit that this rejection should be withdrawn because Nozaki et al '416 does not disclose or render obvious the positive photoresist composition of the present invention.

Claim 1 as amended recites that the resin further contains (1) repeating structure units each having an alicyclic hydrocarbon moiety, and still further contains (2) repeating structure units each having a group which is decomposed by the action of an acid to increase the solubility of the resin in an alkali developing solution.

Since claim 1 now recites (as claim 20 recited) that the resin “further contains” structure units having a group which is decomposed by the action of an acid to increase the resin’s solubility in an alkali developing solution, it is apparent that this language is calling for repeating units other than an alicyclic hydrocarbon moiety. Otherwise, this language of claim 1 would be superfluous since claim 1 as amended already calls for an alicyclic hydrocarbon moiety. Accordingly, the adamantyl group from the 2-methyl-2-adamantyl methacrylate monomer of Nozaki et al cannot be relied upon as satisfying the requirement that the resin of present claim 6 further contain repeating structure units each having a group which is decomposed by the action of an acid to increase the resin’s solubility in an alkali developing solution.

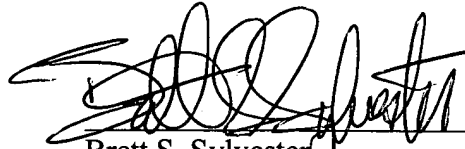
An example of such an acid decomposable group would be the t-butyl group in the t-butyl methacrylate employed in resin (D) of the working examples of the present application. The reference relied upon, Nozaki et al, does not disclose such a resin. The effects of employing such a resin are to improve the sensitivity of the photoresist, as demonstrated in the working examples of the present application.

In view of the above, the Examiner is respectfully requested to reconsider and withdraw the §102(e) anticipation rejection based on Nozaki et al ‘416.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. Application No.: 09/729,953

Allowance is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brett S. Sylvester", written over a horizontal line.

Brett S. Sylvester  
Registration No. 32,765

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: December 20, 2005